

REMARKS

Claims 1-3, 5, and 7-13 are pending in the application.

By the foregoing Amendment, claim 1 is amended to correct typographical and transcription errors, and claim 10 is amended to correct a typographical error. These changes are believed not to introduce new matter, and entry of the Amendment is respectfully requested.

Restriction Requirement under 35 U.S.C. § 121

In the Office Action dated February 16, 2005, election was required of one of the following inventions:

- Invention I, claims 1-3, drawn to a method of making a trench wall in the ground, classified in class 37, subclass 195.
- Invention II, claims 5 and 10, drawn to a trench wall cutter for making a cut trench accompanied by the formation of a free space, classified in class 37, subclass 142.5.
- Invention III, claims 7-9 and 11-13, drawn to a trench wall cutting device for making a trench wall, classified in class 37, subclass 357.

In response to the restriction requirement, applicant elects Invention II, claims 5 and 10, with traverse with respect to the restriction requirement between Inventions II and III.

The Office Action states that inventions II and III are related as combination and subcombination, and goes on to state that “the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require a linear guidance mechanism.”

MPEP 806.05(a), entitled "Combination and Subcombination or Element," provides:

A combination is an organization of which a subcombination or element is a part.

Relative to questions of restriction where a combination is alleged, the claim thereto must be assumed to be allowable (novel and unobvious) as pointed out in MPEP § 806.02, in the absence of a holding by the examiner to the contrary. When a claim is found in a patent, it has already been found by the Office to be allowable and must be treated on that basis.

Pursuant to the definition of a combination and a subcombination set forth in MPEP 806.05(a), as between Inventions II and III, Invention II is the subcombination and Invention III is the combination, inasmuch as claim 11 (Invention III) is an organization of which the trench wall cutter of claim 10 is a part.

Contrary to the assertion in the Office Action, the combination as claimed *does* require the particulars of the subcombination as claimed because every element recited in claim 10 (the subcombination) is also recited in claim 11 (the combination). Further, pursuant to MPEP 806.05(a), and MPEP 806.02 cited therein, for the purpose of a decision on the question of restriction, the combination must be assumed to be allowable. Therefore, the combination as claimed is presumed to require the particulars of the subcombination as claimed for patentability.

Both requirements of MPEP 806.05(c) must be satisfied for restriction to be proper. Requirement (1) as set forth in the Office Action clearly is not met with respect to Inventions II and III. Accordingly, it is respectfully submitted that the restriction requirement is improper with respect to Inventions II and III and should be withdrawn; and that claims 7-9 and 11-13 should be examined along with elected claims 5 and 10.

Conclusion

All requirements have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for examination and allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

JACOBSON HOLMAN PLLC

Date: 3/14/05

By: 

Customer No. 00,136
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666

Allen S. Melser
Registration No. 27,215